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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/462,961 04/10/00 KNOBLICH

J GK-ZEI-3075

EXAMINER

026418 MMC2/0405
REED SMITH LLP
375 PARK AVENUE
NEW YORK NY 10152

ROBINSON, PI	PAPER NUMBER
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2872
DATE MAILED:

04/05/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/462,961

Applicant(s)
Knoblich

Examiner
Mark Robinson

Group Art Unit
2872



☒ Responsive to communication(s) filed on Jan 16, 2001

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 20-39 is/are pending in the application

Of the above, claim(s) 21-24, 33-35, and 37-39 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20, 25-32, and 36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of species a. in Paper No. 8 is acknowledged. Claims 20,25-32 and 36 read on the elected species and will be examined on the merits as follows. It should be noted that claim 25 is generic and will be examined with the elected species.

The traversal is on the ground(s) that the search will be the same for the method and apparatus. However, claims to a both a method and apparatus have not been presented in the application and accordingly this was not the basis for the restriction requirement. Further, applicant has not provided evidence or stated on the record that the species are not patentably distinct as required in the previous office action to overcome the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claims 21-24,33-35 and 37-39 are withdrawn from consideration as being drawn to non-elected subject matter.

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Claim Objections

2. Claims 20 and 29 are objected to because of the following informalities: in claim 20 "the plane of the observation channel" lacks antecedent basis. In claim 29 "the light guide end" lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claims 26,28 and 30-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 26,30 and 31 use of the term "and/or" has rendered the claims indefinite as their scope is unascertainable. For example, in claim 26 it is unclear if the light guide comprises glass, plastic, fluid, or any combination of these materials. Note that the specification does not seem to provide support for a light guide which includes all of these materials.

In claim 28 "the light guide ends" lacks antecedent basis, and it is unclear to what this refers as only one light channel/guide was recited in elected claim 25. This claim is being interpreted as including a single light guide with an end in order to be considered as an elected claim.

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In the last line of claim 32 "the microscope zoom system" lacks antecedent basis. Further, this phrase causes confusion as the only zoom system previously recited was said to be associated with the illumination system. Clarification should be made whether one or two zoom systems are intended to be included in the claim.

Inasmuch as the claims are able to be understood in light of the 112 rejections made above, the following rejection(s) apply:

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 20,25,28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4331635 (Sander) made of record.

Sander shows in figures 1 and 3 an illumination system including an illumination channel(5b) arranged in a plane

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orthogonal to a plane containing observation channels(12a,12b) and having a light guide(25). Note that the illumination is carried out via optics(29) following the end(27) of the light guide.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26,27 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sander (DE '635).

With respect to claim 26, although not explicitly taught by Sander, flexible light guides (such as optical fibers) of glass, plastic, etc. are well known and use thereof in Sander's device would have been obvious to the ordinarily skilled artisan at the time of invention in order to allow flexibility in arranging the light source.

With respect to claim 27, Sander does not show the light guide to extend at least partially into the microscope housing.

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However, such an arrangement is common and would have been obvious at the time of invention as a means to support the end of Sander's light guide in proper alignment with the rest of the system.

With respect to claim 36, although not taught by Sander, cold-light sources are well known and use thereof would have been obvious to the ordinarily skilled artisan at the time of invention depending on the type of observation to be performed of the sample.

8. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sander (DE '635) in view of Takagi et al (5,140,458).

Sander does not show a controllable illumination zoom system coupled to a zoom system of the microscope. However, such arrangements are known and an example is shown by Takagi (note microscope zoom OLz and illumination zoom ILz). It would have been obvious to the ordinarily skilled artisan at the time of invention to include Takagi's zoom arrangements in Sander's device in order to allow for viewing the sample using various magnifications.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morizumi shows a zooming microscope with observation and illumination channels in orthogonal planes. Greenberg shows a microscope illumination system with movable light guides. Moller et al show a microscope with observation and illumination channels in orthogonal planes and a light guide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Mark Robinson

Patent Examiner

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3/30/01